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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,710	07/15/2002	Gracme Deaker	TJK/216	3993
27717	7590	02/23/2011		
SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803			EXAMINER AGWUMEZIE, CHARLES C	
			ART UNIT 3685	PAPER NUMBER
			MAIL DATE 02/23/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,710

Applicant(s)

DEAKER ET AL.

Examiner

CHARLES C. AGWUMEZIE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-82 and 85-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-82 and 85-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-949)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/27/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 1, 2011 has been entered.

Acknowledgments

2. Applicants' amendment filed on February 1, 2011 is acknowledged. Accordingly claims 79-82 and 85-96 remain pending and have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 79-82, and 85-88**, are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to a particular machine or apparatus (machine implemented) or (2) particularly transform a particular article to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claims 79-82 and 85-88 fails both prong (1) because the "tie" (e.g. offering, receiving, issuing, generating, associating, receiving, comparing and validating) is representative of extra-solution activity and/or not tied to any particular machine or apparatus. Additionally, the claim(s) fail prong (2) because the method steps do not particularly transform a particular article to a different state or thing. Accordingly these claims are directed to non-statutory subject matter.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 79-82, and 85-96**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106 in view of Messner U.S. Patent No. 6,370,514 B1 and further in view of Scroggle et al (hereinafter "Scroggle") U.S. Patent No. 6,014,634.

7. As per **claims 79, 89 and 90**, Walker et al discloses a payment method comprising:

offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers;

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

receiving an order from said customer for said prepaid voucher (see fig. 7A, *which discloses receive request to purchase gift code and amount of money to be credited to gift code record step 126*);

said order specifying a selected one of said plurality of subscriber retailer and including a payment from said customer;

receiving payment from said customer for said prepaid voucher via a computer network (see fig. 7B, *which discloses transmit credit card number and amount of money to be credited to transaction processing network/credit card processor for gift code authorization*);

issuing said prepaid voucher in response to receiving said order and said payment from said customer (see fig. 7A, *which discloses generate gift code step 128; store requested value in gift code record step 130*),

said pre-paid voucher including voucher information identifying the selected subscriber retailer

generating a token associated with said prepaid voucher (see fig. 7A, *which discloses generate gift code step 128; generate and transmit ID code to buyer step 122*);

associating said token with said prepaid voucher in a database (see fig. 7B, *which discloses flag gift certificate record as prepaid and store authorization code step 144*);

receiving a request from one of said plurality of subscriber retailers for validation of said issued prepaid voucher in response to presentment of said issued prepaid

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voucher from said customer to said one of said plurality of subscriber retailers, said request including said token (col. 8, lines 40-55, *which discloses the process starting (step 162) with central controller 12 receiving a gift certificate code (step 163) via a transmission from a redeemer operating the buyer/redeemer interface 16 via the Internet*);

comparing said token in said request against said token associated with said prepaid voucher in said database (col. 11, lines 30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*); and

validating said prepaid voucher in response to a positive result of said comparison (col. 11, lines 30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*).

8. What Walker does not explicitly teach is

offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers;

said order specifying a selected one of said plurality of subscriber retailer and including a payment from said customer;

said pre-paid voucher including voucher information identifying the selected subscriber retailer

9. Messner discloses the method comprising:

offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers (*see fig. 3, which discloses plurality of subscriber retailers; col. 2, lines 1-5, which discloses that it is an object of the present invention to provide a centralized system based on a voucher server, which system can handle marketing and redemption of vouchers for a number of participating third party merchants/virtual malls. This centralized processing frees participating merchants from having to develop the in-house technical expertise necessary to administer such a system*);

10. Scroggle discloses

said order specifying a selected one of a plurality of subscriber retailer and including a payment from said customer (*see fig. 11, which discloses*

redeemable only at Ralphs; see col. 1, line 45-col. 2, line 5, which discloses For security reasons, the transmitted incentive may be encoded with the identity of the retailer selected by the customer, and preferably also contains a customer identification code);

said pre-paid voucher including voucher information identifying the selected subscriber retailer (*see fig. 11, which discloses redeemable only at Ralphs; see col. 1, line 45-col. 2, line 5, which discloses that :for security reasons, the transmitted incentive may be encoded with the identity of the retailer selected by the customer, and preferably also contains a customer identification code);*

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers; said order specifying a selected one of a plurality of subscriber retailer; said pre-paid voucher including voucher information identifying the selected subscriber retailer in view of the teachings of Messner and Scroggle in order to ensure adequate security and free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

11. As per claim 80, Walker failed to explicitly disclose the payment method, further comprising:

communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison.

Messner discloses the payment method, further comprising:

communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison (see fig. 2).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison in view of the teachings of Messner in order to free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

12. As per claim 81, Walker failed to explicitly disclose the method, further comprising:

receiving a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation; and

indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use.

Messner discloses the method, further comprising:

receiving a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation (see fig. 2A); and

indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use (see fig. 2A).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising receiving a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation; and indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use in view of the teachings of Messner in order to ensure adequate security and free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

13. As per claim 82, Walker further discloses the method, further comprising:
said order being received from said customer via a computer network (col. 8, lines 40-55).

14. As per claims 85 and 95, Walker failed to explicitly disclose the method, wherein issuing said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber.

Scroggle discloses the method, wherein said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber (see fig. 11, which discloses redeemable only at Ralphs)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method comprising said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber in view of the teachings of Scroggle in order to ensure security

15. As per claim 86, Walker further discloses the method, further comprising:
delivering said prepaid voucher to a recipient via postal service (col. 8, lines 10-25).

16. As per claim 87, Walker further discloses the method, further comprising:
delivering said prepaid voucher to said recipient via electronic mail (fig. 7A).

17. As per claim 88, Walker failed to explicitly disclose the method, wherein said token comprises a randomly generated token.

Scroggle discloses disclose the method, wherein said token comprises a randomly generated token (col. 11, lines 10-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method wherein said token comprises a randomly generated token in view of the teachings of Scroggle in order to ensure security

18. As per claim 91, Walker further discloses the system, further comprising:
said redemption system configured to cause said prepaid voucher in response to said request (col. 11, lines 30-45).
19. As per claim 92, Walker further discloses the system, further comprising:
said request descriptive of a partial use of said prepaid voucher (see fig. 5); and
said redemption system configured to indicate said partial use of said voucher in response to said request (see fig. 5).
20. As per claim 93, Walker further discloses the system, further comprising:
a payment system in communication with said network, said payment system configured to approve said payment (see fig. 7A-C).
21. As per claim 94, Walker failed to explicitly disclose the system, further comprising:

said at least one database including voucher image data for said prepaid voucher; and
said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data.

Scroggle discloses the system, further comprising:

said at least one database including voucher image data for said prepaid voucher; and
said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data (see fig. 11; see abstract; col. 2, lines 55-65)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said at least one database including voucher image data for said prepaid voucher; and said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data in view of the teachings of Scroggle in order to ensure adequate security

22. As per claim 95, Walker failed to explicitly disclose the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers.

Scroggle discloses the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers (see fig. 11; col. 10, lines 25-60; col. 11, lines 10-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said voucher image is associated with each of said plurality of subscribing retailers in view of the teachings of Scroggle in order to ensure security

- 23.** As per claim 96, Walker further discloses the system, further comprising:
said website configured to receive a beneficiary designation for said prepaid voucher from said customer and to cause delivery of said prepaid voucher to said beneficiary (see fig. 6, which shows names of beneficiaries).

Conclusion

- 24.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
February 22, 2011